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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,240	03/11/2004	Dale J. Carter	2635.CIRQ.NP	3555
26986	7590	06/13/2005	EXAMINER	
MORRISS O'BRYANT COMPAGNI, P.C. 136 SOUTH MAIN STREET SUITE 700 SALT LAKE CITY, UT 84101			AWAD, AMR A	
			ART UNIT	PAPER NUMBER
			2675	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/798,240	CARTER ET AL.
	Examiner	Art Unit
	Amr Awad	2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 March 2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 12/10/04.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 18 is objected to because of the following informalities: in line 1, the claim is not referring to a particular claim. The Examiner will assume that the claim depends on claim 16. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites "and combination devices that include at least two of the functions above." This limitation is not clear because it is not clear what "the functions above" is referring to. Claim 4 recites, "and any other sensing technology that enables detection of contact of a user on the at least one second sensor". This limitation is indefinite because the term "any" does not specify a tangible limitation.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 4, 9-10, 12-15, 17, 22-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Molne (US patent NO. 6,243,080).

As to independent claim 1, Molne (figure 1) teaches a portable electronic appliance (cellular phone 10) comprising: a portable electronic appliance having a housing (the body of the phone), a data entry device (keypad 16) and a display screen (18); at least one second sensor (touch-sensitive panel 30) disposed on a surface of the housing such that a user can make physical contact with the at least one second sensor (col. 3, lines 2-24); and wherein the at least one second sensor provides contact data to a sensor circuit disposed within the portable electronic appliance (col. 3, lines 18-24), wherein the contact data in the sensor circuit is utilized by a processor (microprocessor 122 in figure 6) within the portable electronic appliance to determine whether or not to activate or deactivate a predetermined function of the portable electronic appliance (abstract, wherein the touch-sensitive can activate or deactivate the selection mode).

As to claim 2, Molne shows that the portable electronic appliance is selected from the group of portable electronic appliances comprised of a laptop computer, a mobile telephone, a personal digital assistant, a global positioning system, an electronic compass, a camera, a camcorder, and combination devices that include at least two of the functions above (in Molne, the device is a mobile phone shown in figure 1).

As to claim 4, Molne shows that the at least one second sensor is selected from the group of sensors comprised of pressure sensitive, electrostatic, and any other sensing technology that enables detection of contact of a user on the at least one second sensor (Molne shows pressure sensitive; col. 4, lines 33-50).

As to claim 9, Molne shows that the at least one second sensor is comprised of at least one general purpose touchpad that can sense position as well as touch or proximity of a touching object to the touchpad (col. 3, lines 18-23).

As to claim 10, Molne shows that the at least one second sensor is comprised of at least one single-layer touchpad that can sense touch or proximity of a touching object to the touchpad (figure 2 and col. 3, lines 18-23).

As to claim 12, Molne shows that the functions that can be activated or deactivated using the at least one second sensor are selected from the group of functions comprised of turning on, turning off, increasing volume, decreasing volume, engaging a speakerphone mode, disengaging a speakerphone mode, toggling from a first function to a second function, and toggling from a second function back to a first function (Molne shows toggling from a first function to a second function (i.e., selecting and de-selecting)) (abstract).

As to independent claim 13, the claim is substantially similar to claim 1 by considering the selecting and unselecting states described in the abstract as the claimed limitation of activating or deactivating a predetermined function.

As to claims 14-15, 17, 22-23 and 25, these claims are method claims corresponds to the apparatus of claims 1-2, 4, 9-10 and 12 and would be analyzed as previously discussed with respect to these claims.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 5-8, 16 and 18-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Molne in view of Davis (US patent No. 6,292,674).

As can be seen above, Molne teaches all the limitations of claims 3, 5-8, 16 and 18-21 except the citation of having the at least one second sensor comprised of a capacitance sensitive touchpad. Note that Molne shows that the touchpad (30) is capable of confirming to arcuate surfaces (as seen in figure 2) wherein the spring can take arc shape. Molne also shows that the touchpad is capable of sensing touch (col. 3, lines 18-24).

However, Davis (figures 2-7) shows a hand-held wireless telephone (706) that includes housing (710), and includes a capacitive touchpad (col. 5, lines 51-64).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Davis having capacitive sensing touchpad, to be incorporated to Molne because the capacitive touch sensing is well known in the art, and known to be accurate and reliable.

8. Claims 11 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molne in view of Reber et al. (US patent NO. 6,418,325; hereinafter referred to as Reber).

As seen above, Molne teaches all the limitations of claims 11 and 24 except the citation of having an orientation sensor for determining the orientation of the portable device.

However, Reber (figures 1 and 3-4) teaches a portable phone (100) that includes orientation sensor (48 & 49) (col. 6, lines 53-60).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Reber having an orientation sensor to be incorporated to Molne's device so as to be able to change the data displayed on the display based on the orientation of the device, and therefore, make the device user friendly.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Norimatsu (US patent NO. 5,329,577) teaches a telephone having touch sensor responding to a call.

Fujii et al. (US patent NO. 6,664,951) teaches a mobile communication terminal equipment and touch panel switch used therein.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amr Awad whose telephone number is (571) 272-7764.

The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571)272-3638. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. A.

AMR A. AWAD  
PRIMARY EXAMINER

